REMARKS

Claims 21-38 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The Office Action rejects claims 21-25, 27-31, and 33-37 under 35 U.S.C. § 102 as being anticipated by *Rowley* (US Patent No. 5,999,740). This rejection is respectfully traversed.

With respect to independent claims 21, 27, and 33, the Office Action states:

> As per claims 21, 27, and 33, Rowley teaches a method, an apparatus, and a computer program product in a computer-readable medium for communicating over Internet comprising: responsive to receipt of a signal to transmit information from the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted (see col. 1, lines 30-37); generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission (see Fig. 9); and responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection (see col. 5, lines 59-61).

Office Action, dated December 11, 2003. Applicants respectfully disagree. *Rowley* teaches an updating mechanism for software, wherein a server transmits software updates to a client. A user selects applications for update in a user interface and the application updates are downloaded from a remote file server. The user may cancel the download from the remote file server to the user's device.

In contradistinction, the present invention provides a mechanism for generating a message that presents at least one information element being transmitted and a cancel control for canceling transmission. Claim 21 recites:

> 21. A method, in an Internet processor, for communicating over the Internet, the method comprising:
>
> responsive to receipt of a signal to transmit information from the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted;
>
> generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission; and

responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection.

As is discussed more fully below, the Applicants have been consistent in their definition of the "Internet processor" as a client device. Thus, the present invention identifies at least one information element within the information to be transmitted **responsive to receipt of a signal to transmit information from the Internet processor over an established Internet connection**. The present invention also generates a message that **presents the at least one information element** and includes a **cancel control for canceling transmission**. Note that the potential transmission and presentation of the information occur in the same client device. *Rowley* does not teach or suggest these features.

The cited portions of *Rowley* state:

> (a) means for accessing a remote file server to obtain a release file containing a list of software applications available from the remote server and their current version details;
> (b) means for comparing said release file with said registration file to determine which of the installed applications have upgrades available;
> (c) user interface means for allowing a user to select at least one of said applications for upgrading;

Rowley, col. 1, lines 31-37.

> Alternatively, the user may simply exit from the program without performing any updates by selecting the "Cancel" button.

Rowley, col. 5, lines 59-61. Thus, *Rowley* teaches a user interface at the client for selecting an application for upgrading and a cancel control for canceling a transmission **from** a server to a client. *Rowley* does not teach or suggest "generating a message, wherein the message presents the at least one information element," as recited in claim 21. The cited portion of *Rowley* teaches canceling an update; however, this update includes information to be transmitted **to** the Internet processor, rather than **from** the Internet processor, as in claim 21. The process in *Rowley* is a different process from that of the present invention. In fact, *Rowley* does not even address the problem being solved by the present invention, client privacy.

The Office Action states:

> In response to the argument regarding the teachings of Rowley, Rowley clearly teaches the limitation of "generating a message..." and "cancel control for canceling transmission... of the information over the established Internet connection" (see references provided). It is noted that the transmission of "to" and "from" is not explicitly mention, but rather "communicating over Internet". Additionally, one of ordinary skill in the art would question which specific device is an "Internet processor", and concur that any device able to transmit and receive data, via the Internet, which includes a processor is an Internet processor. Therefore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Office Action, dated December 11, 2003. Applicants respectfully disagree. Clearly, the Applicants are entitled to be their own lexicographer. The Office Action appears to argue that the words "from" and "to" may be given different interpretations depending upon the perspective of the "Internet processor" and that an "Internet processor" may be interpreted as "any device able to transmit and receive data, via the Internet, which includes a processor."

However, assuming *arguendo* that the Examiner is entitled to argue that the server is the Internet processor, the Office Action proffers no explanation as to how these interpretations apply to the *Rowley* reference or how *Rowley* anticipates the claimed invention under these interpretations. Rather, it appears that the Office Action is giving the terms no meaning whatsoever, since the Office Action does not explain how the claimed features are somehow taught by *Rowley*. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Therefore, the Office Action fails to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, because the Office Action does not

show where each and every claim limitation is taught in the *Rowley* reference, particularly under the specific interpretations argued in the Office Action.

Specifically, the preamble of claim 21, recites "[a] method, **in an Internet processor**, for communicating over the Internet..." [emphasis added]. The body of claim 21 presents further limitations to this method; however, as recited, the method is practiced **in an Internet processor, i.e. a single machine**. As stated above, a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. If indeed, the Internet processor is the server as the Examiner argues, *Rowley* does not teach or fairly suggest a step of "responsive to receipt of a signal to transmit information from the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted." In *Rowley*, this step is not performed **in the Internet processor**, but the client device.

In *Rowley*, application updates are transmitted from a remote file server to a client device. Even if one were to interpret the term "Internet processor" to read on the remote file server of *Rowley*, the reference fails to teach or fairly suggest a step of "generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission," where the step is performed **at the remote file server**. Still further, *Rowley* fails to teach or fairly suggest a step of "responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection," where this step is performed entirely **at the remote file server**. At best, in Rowley, the cancellation of transmission may occur at the remote file server, but the election would occur at the client.

Clearly, *Rowley* does not anticipate the claimed invention under this interpretation which is what the Applicants currently understand as the Examiner's position. So if this is not the Examiner's position, the Examiner should be prepared to answer the following questions with reference to the recited claim language: which element in *Rowley* is interpreted to be an "Internet processor," as recited in the instant claims? Which element in *Rowley* receives a signal to transmit information from the Internet processor over an established Internet connection? Which element in *Rowley* identifies at least one information element within the information to be transmitted? Which element in *Rowley*

generates a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission? Which element in *Rowley* cancels transmission of the information over the established Internet connection responsive to selection of the cancel control? Applicants submit that *Rowley* fails to teach an Internet processor in which the steps of claim 21 are performed.

Since the applied reference fails to teach or suggest each and every claim limitation, claim 21 is not anticipated by Rowley. Independent claims 27 and 33 recite subject matter addressed above with respect to claim 21 and are allowable for the same reasons. Since claims 22-25, 28-31, and 34-37 depend from claims 21, 27, and 33, the same distinctions between *Rowley* and the invention recited in claims 21, 27, and 33 apply for these claims. Additionally, claims 22-25, 28-31, and 34-37 recite other additional combinations of features not suggested by the reference.

More particularly, with respect to claims 22, 28, and 34, the Office Action states:

> As per claims 22, 28, and 34, Rowley further teaches wherein the message includes a selection control for each information element disclosed in the message (see Fig. 9 and col. 5, lines 35-53).

Office Action, dated December 11, 2003. Applicants respectfully disagree. *Rowley* fails to teach or suggest "responsive to receipt of a signal to transmit information from the Internet processor (the client) over an established Internet connection, identifying at least one information element within the information to be transmitted" and "generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission," as recited in representative claim 21. Therefore, it follows that *Rowley* also fails to teach or suggest the further limitation of a selection control for each information element disclosed in the message.

As stated above, *Rowley* teaches canceling an update, which includes information to be transmitted **to** the Internet processor, rather than **from** the Internet processor, as in claim 21. While the Applicants' arguments are necessarily semantic in that they are concerned with the particular words in the claims, the Examiner is respectfully urged to consider that the Applicants' arguments are more than a debate over which preposition is the correct one to use. The words in the claims were chosen with care to recite the Applicants' invention for improving client privacy. *Rowley* fails to even address this

problem, and does not teach or suggest the claimed invention. Therefore, claims 22, 28, and 34 are not anticipated by *Rowley*.

Furthermore, with respect to claims 23-25, 29-31, and 35-37, the Office Action states:

> As per claims 23, 29, and 35, Rowley further teaches wherein each selection control is selected by default (see col. 5, lines 54-57).
>
> As per claims 24, 25, 30, 31, 36, and 37, Rowley teach of further comprising: responsive to deselection of a selection control, blocking transmission of the information element corresponding to the selection or deselection control (see Fig. 9).

Office Action, dated December 11, 2003. Applicants respectfully disagree. *Rowley* fails to teach or suggest "a selection control for each information element disclosed in the message," as recited in representative claim 22. Therefore, it follows that *Rowley* also fails to teach or suggest the further limitation of each selection control being selected by default. One would assume that when a user requests a software update in *Rowley*, the user wishes to have the software update transmitted to the client device from the remote file server. As such, there would be no need for a selection control and certainly *Rowley* does not teach or even suggest that the selection control would be selected by default, because only new or updated files are downloaded. There would be no need for selection or deselection of a selection control because only needed files are downloaded for a software update in *Rowley*. Therefore, claims 23-25, 29-31, and 35-37 are not anticipated by *Rowley*.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 21-25, 27-31, and 33-37 under 35 U.S.C. § 102.

Furthermore, *Rowley* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Rowley* actually teaches away from the presently claimed invention because it teaches a control for canceling transmission of information to an Internet processor, as opposed to a control for canceling transmission of information from an Internet processor, as in the presently claimed invention. Absent the Office Action pointing out some teaching or incentive to implement the teachings of *Rowley* to perform contrary to what is taught by the reference, one of ordinary skill in the art would not be led to modify *Rowley* to reach the present

invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Rowley* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

II. 35 U.S.C. § 103, Obviousness

The Office Action rejects claims 26, 32, and 38 under 35 U.S.C. § 103 as being unpatentable over *Rowley* in view of *Reha et al.* (US Patent No. 6,282,709). This rejection is respectfully traversed.

With respect to claims 26, 32, and 38, the Office Action states:

> Rowley teaches all the limitations of claims 26, 32, and 38 except wherein the message presents the address of the Internet server to which the information is to be transmitted. Reha teaches wherein the message presents the address of the Internet server to which the information is transmitted (see col. 10, lines 63-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Reha within the system of Rowley by presenting the Internet server address to which the information is to be transmitted within the Internet communicating method, apparatus, and program because this would provide the user with additional information and allow the user to have additional control to continue or cancel the update transmission.

Office Action, dated December 11, 2003. Applicants respectfully disagree. As stated above, *Rowley* teaches canceling an update, which includes information to be transmitted **to** the Internet processor, rather than **from** the Internet processor, as in claim 21. The process in *Rowley* is a different process from that of the present invention. In fact, *Rowley* does not even address the problem being solved by the present invention, client privacy. *Reha* does not make up for the deficiencies of *Rowley*. To the contrary, *Reha* suffers from the same deficiencies as *Rowley*. The cited portion of *Reha* teaches, "a server address for a server containing possible updates for a component of the at least one software program." See *Reha*, col. 10, lines 63-65. Thus, *Reha* is also concerned with transmission of information **to** an Internet processor **from** a server, and like *Rowley* is concerned with software updates rather than client privacy.

Furthermore, *Reha* teaches that the server address is included in a software component definition file. *Reha* does not teach or fairly suggest generating a message that presents the server address, so that the user can understand whether he or she wants that particular piece of information to go to that particular server, as alleged in the Office Action. Thus, even assuming, *arguendo*, that a person of ordinary skill in the art were motivated to combine *Rowley* and *Reha*, the combination would not result in the presently claimed invention.

The applied references, taken alone or in combination, fail to teach or suggest each and every claim limitation; therefore, claims 26, 32, and 38 are not rendered obvious by the proposed combination of *Rowley* and *Reha*. Therefore, Applicants respectfully request withdrawal of the rejection of claims 26, 32, and 38 under 35 U.S.C. § 103.

III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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